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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,689	07/03/2003	Eric Chalendar	D-7871	7323

7590 10/31/2005

MeadWestvaco Corporation
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EXAMINER

HARMON, CHRISTOPHER R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

THA

Office Action Summary	Application No. 10/613,689	Applicant(s) CHALENDAR ET AL.	
	Examiner Christopher R. Harmon	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/14/05 has been entered.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 as follows:

Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. PCT/US02/00242 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be timely made in this application. To satisfy the requirement of 37 CFR 1.55(a)(2) for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the apparatus capable

of placing cartons around the arrays (a portion of the array is encompassed by the insert/carton 1, however not is not placed around the array) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. The specification distinguishes an insert from a carton, however no cartoning device is depicted. Even if insert I of the invention is considered a "carton" it is uncertain how the "carton" is placed around the array of articles.

The limitation "material prior transfer to the placement" (claim 11, line 2) is confusing and indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(b) as anticipated by Greenwell et al (#5,862,648).

Greenwell et al show an apparatus comprising placing packaging material in a pre-determined position relative to an array of articles 28 wherein the feed means for feeding the packaging material is substantially perpendicular to the horizontal direction of travel. The feed means for the packaging material comprises an endless belt 12 with lugs 20, 21 to hold the packaging material. Greenwell et al show pickup means from magazine 13 wherein the packaging material is placed on the feeding means 12 as well as the packaging material being insert means as shown in figures. Greenwell et al disclose synchronizing means to ensure the placing of the packaging material by using control drive means including suitable means, such as, servo motors or other motor or

solenoid devices which could be programmed or oriented to produce the desired indexable movement (col 8 lines 41+).

8. Claims 1- 5, 7-8, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ganz (US 3,190,048).

Ganz discloses an apparatus for placing packaging material 20 in a pre-determined position relative to an array of articles 37 comprising conveyor 119; fixed feed means 103 and 105 for feeding the packaging material/inserts from an upstream direction substantially perpendicular to the direction of travel of the articles 37; see figures 3B and 8. The placement is synchronized with the arrays passing underneath the feed means. Inherently a controller is provided to actuate the drive means for the endless belts 99, 100 of the feed means and chains with lugs 119, etc.

Regarding claim 7, pick up means 83 is arranged to accept the packaging material/inserts from conveyor 24 and transfer them downstream to the feed means.

Regarding claims 10-12, Ganz discloses rollers 69 and folding bars 86 and 87 for erecting the insert to a final position in an "erecting and compression station".

9. Claims 1-4, 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Page et al. (US 5,813,196).

Page et al. disclose an apparatus for packaging an array of articles 11" comprising article conveyor 13; feed means 52 for feeding packaging material 12 from a substantially perpendicular direction to the article conveying direction which is "upstream" along rack 49. The packaging material 12 is moved with sufficient velocity in order to be in place for the incoming array of articles 11".

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenwell et al (#5,862,648) in view of Applicant's Admitted prior art (AAPA).

The common knowledge modification taken in the previous rejection of 9/30/04 was not timely traversed by applicant. Therefore, a controller comprising a central processor with manual input means is taken to be admitted prior art since applicant did not traverse examiner's assertion of official notice.

Response to Arguments

12. Applicant's arguments with respect to claims 1-16 have been considered but are not persuasive. The amendment to claims 1 and 10 in order to now read "from an upstream direction of travel" does not distinguish over Greenwell. Items conveyed in any direction are considered from an upstream direction. The feed means secures packaging material from above (vertical direction), which is substantially perpendicular to the article conveying direction (horizontal). During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). See MPEP § 904.1.

Regarding the common knowledge modification in the rejection of claims 13-16, the response of 12/30/04 does not directly traverse the Official Notice. The failure to contest this particular point in the is deemed to be admitted prior art; see MPEP 2144.03. The common knowledge modification of Greenwell regarded the control means - a central processor and input means (e.g. CPU and keyboard) that could effectively control separate means/pick up means (see above) for positioning of the packaging material. Applicant admits that central processors are well known (page 8, second paragraph) however does not specify which elements of claim 13 are now being argued (ie. input means?).

Conclusion

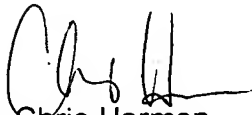
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Harmon whose telephone number is (571) 272-4461. The examiner can normally be reached on Monday-Friday from 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Chris Harmon", with a stylized flourish at the end.

Chris Harmon
Patent Examiner